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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/058,506	01/28/2002	Rintaro Yamamoto	NGB-12947	2233
40854	7590	09/30/2004	EXAMINER	
RANKIN, HILL, PORTER & CLARK LLP 4080 ERIE STREET WILLOUGHBY, OH 44094-7836			LUDLOW, JAN M	
			ART UNIT	PAPER NUMBER
			1743	

DATE MAILED: 09/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/058,506

Applicant(s)

YAMAMOTO, RINTARO

Examiner

Jan M. Ludlow

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) 7-11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 March 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
2. I Claims 1-6, drawn to a fluid transfer device, classified in class 422, subclass 100.
3. II Claims 7-11, drawn to a vessel, classified in class 422, subclass 102.
4. The inventions are distinct, each from the other because of the following reasons:
5. Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as pipetting into conventional vessels. See MPEP § 806.05(d).
6. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
7. During a telephone conversation with David Spaw on September 27, 2004 a provisional election was made without traverse to prosecute the invention of group I, claims 1-6. Affirmation of this election must be made by applicant in replying to this Office action. Claims 7-11 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.
8. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

9. Claims 1-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

10. In claim 1, lines 6-8, it is unclear whether the connection mechanism connects to either atmosphere or the pressure mechanism, or to both atmosphere and the pressure mechanism alternately. For purposes of examination, the claim has been interpreted in view of the specification to connect to both alternately. In claim 1, line 7, "outer" should be "other" for clear antecedence. In claim 3, line 3, "being brought..." is unclear because it recites a method step, rather than a structural limitation. In claims 4-5, line 3, "securing the capillary" is unclear—securing to what? For purposes of examination, the claims have been interpreted as "securing the capillary to the capillary support".

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

12. A person shall be entitled to a patent unless –

13. (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

14. (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

15. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Little et al.

16. Little teaches capillary 64, pressure mechanism 84, connection mechanism 80, 52, 54, switching mechanism 82, support 54, and hermetic space formation member or pressure unit 52. Fig. 2.

17. Claims 1,3 are rejected under 35 U.S.C. 102(e) as being anticipated by Jovanovich.
18. Jovanovich teaches capillary 12, support 10, connection mechanism 301, pressure mechanism 305, pressure unit 306, 310. Fig. 4 A-B.
19. Claims 1, 3 are rejected under 35 U.S.C. 102(b) as being anticipated by Hanaway et al.
20. Hanaway teaches capillary 90, support 16, 18, connection mechanism 48, pressure unit 62, 66 and hermetic space surrounded by 56. Figs. 1-4, 8.
21. Claims 4-6 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.
22. The following is a statement of reasons for the indication of allowable subject matter: The prior art fails to teach or suggest the invention as claimed.
23. With respect to claims 4-5, Little fails to teach or suggest the diaphragm, and it would not have been obvious to provide one because it would block the vent.
24. With respect to claims 4-5, Jovanovich teaches foam rubber member 304 below the support 10, first chamber 313, second chamber 307 and elastic membrane 308, and gasket 312 connecting the first pressure chamber (313) to the support. In that the capillaries are adhered to the support, there is no motivation to provide an elastic member for securing the capillary to the support, and there is no motivation to replace gasket 312 with o-ring(s) as claimed.

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25. With respect to claim 6, Yassinzadeh teaches a capillary coupled to a hermetic chamber with a heater for moving fluid, but fails to teach or suggest connection mechanism for connecting of the "other" end of capillary to atmosphere, in that the pressure chamber must be sealed to trap the gas to effect pressure changes on heating.
26. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
27. Haskamp teaches the alternatives of drivers and pressure chambers in membrane pipettors.
28. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jan M. Ludlow whose telephone number is (571) 272-1260. The examiner can normally be reached on Monday-Thursday, 11:30 am - 8:00 pm.
- If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill A. Warden can be reached on (571) 272-1267. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jan M. Ludlow
Primary Examiner
Art Unit 1743

Jml
September 27, 2004